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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,182	06/27/2001	Francis Sykes	Q64932	9304

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EXAMINER
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GELIN, JEAN ALLAND

ART UNIT	PAPER NUMBER
	2681

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/891,182	SYKES ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jean A Gelin	2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 22 July 2004.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Claim Objections***

1. This is in response to the Applicant's arguments received July 22, 2004 in which claims 1-11 are currently pending.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: the acronym "etc.," should be deleted. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linkola (WO 99/41927) in view of Alperovich et al. (US 6,233,448).

Regarding claim 1, Linkola teaches a method of managing the operation of a mobile terminal (MS) of a telecommunications network (fig. 1) as a function of the geographical position of that mobile terminal (page 1, lines 4-7), the network being divided into geographical cells each corresponding to the coverage area of a base station adapted to exchange data with the mobile terminal by radio, the position of the mobile terminal being defined continuously when it is in operation by location data that is a function of at least one base station (i.e., illustrated in fig. 1 is the network divided in

many cells, typically as the MS is moving the location of the MS is being updated, page 11, lines 13-20), the method being of the type in which at least two separate geographical areas and at least one operating feature of the mobile terminal specific to each area are defined (page 7, lines 24-29), wherein each area is geographically defined by location data that is a function of a set of base stations including at least one of the base stations contained in the area (page 11, line 13 to page 12, line 2), location data of the areas and operating features specific to the areas are stored in a memory of the mobile terminal (page 13, line 18 to page 14, line 10), location data of the mobile terminal is compared to the location data of the areas to deduce in which area the mobile terminal is located (page 13, line 18 to page 14, line 10).

Linkola does not specifically teach the operating feature specific to an area is applied as soon as the mobile terminal is located in that area.

However, the preceding limitation is known in the art of communications.

Alperovich teaches automatically activating a feature based upon the current position of mobile station (col. 2, lines 4-40). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Alperovich within the system of Linkola in order to select actions associated with each particular location when the current position of the mobile station matched the preselected location stored within the mobile station, and provide a way to automatically forward calls to an appropriate directory number based upon the current position of a mobile station.

Regarding claim 2, Linkola in view of Alperovich teaches all the limitations above. Linkola further teaches wherein at least one area is defined by location data that is a function of a reference base station and at least one other base station in the environment of the reference base station (page 11, line 20 to page 12, line 23).

Regarding claims 3-5, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein the location data of the areas and the operating features specific to the areas are entered directly via the mobile terminal (i.e., upon a match of the current location and the preselected location at the mobile station, the feature is activated, col. 2, lines 1-40, col. 4, lines 26-33)

Regarding claim 6, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein the operating features of the mobile terminal concern adjusting an operating parameter of the mobile terminal as a function of its location, such as activating call forwarding, adjusting the local time (col. 3, lines 23-24, col. 4, line 33 to col. 5, line 20).

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Regarding claim 7, Linkola in view of Alperovich teaches all the limitations above. Linkola further teaches wherein there is at least one area containing more than one base station (fig. 1).

Regarding claim 8, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein there is at least one area associated with a plurality of operating features of the mobile terminal specific to that area (col. 5, line 60 to col. 6, line 19).

Regarding claim 9, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein there are more than two areas associated with a plurality of operating features of the mobile terminal specific to those areas (col. 5, line 60 to col. 6, line 19).

Regarding claim 10, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein reference data and operating features of the mobile terminal corresponding to that reference data are also stored in a memory of the mobile terminal, data sent to the mobile terminal by the base station of the cell in which the mobile terminal is located is compared with the stored reference data, and the operating feature of the mobile terminal corresponding to the stored reference data is applied as soon as that reference data matches the data sent by the base station of the cell in which the mobile terminal is located (col. 2, lines 1-40).

Regarding claim 11, Linkola in view of Alperovich teaches all the limitations above. Alperovich further teaches wherein one operating feature of the mobile terminal concerns prohibition of modification by a user of data stored in the memory of the mobile terminal (col. 4, line 3 to col. 5, line 28).

### ***Response to Arguments***

5. Applicant's arguments filed 07/22/04 have been fully considered but they are not persuasive.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily

combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). however, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA 1969). In this case, the Applicant argues Linkola is related to changing service profiles of a mobile station, and Alperovich is related to activating and deactivating of a feature based on the location of the mobile. Given the different goals of the two cited references, there would be no motivation for a skill artisan to combine these two references. Even assuming, arguendo, that a skilled artisan were to combine the two references, there is no reasonable expectation of success. However, the Examiner would like to draw the Applicant's attention to the fact that Alperovich is cited solely to teach the idea of being able to activate certain feature when the mobile is within a specific area. The idea that Linkola is not related to changing feature based on the location is irrelevant. The Examiner reiterates that Alperovich teaches automatically activating a feature based upon the current position of mobile station (col. 2, lines 4-40). Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to implement the technique of Alperovich within the system of Linkola in order to select actions associated with each particular location when the current position of the mobile

station matched the preselected location stored within the mobile station, and provide a way to automatically forward calls to an appropriate directory number based upon the current position of a mobile station. The Examiner maintains the previous rejection (recited above) since such a suggestion is taught by Alperovich.

The Applicant argues that claims 2-11 are patentable because they depend on claim 1. Given that the rejection of claim 1 is maintained, therefore claims 2-11 are rejected for the same reason recited above.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean A Gelin whose telephone number is (703) 305-4847. The examiner can normally be reached on 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEAN GELIN  
PRIMARY EXAMINER

JGelin  
October 8, 2004

*Jean Gelin*